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MAILED
AUG 17 2010
OFFICE OF PETITIONS

In re Application of	:	
Fein	:	
Application No. 10/706,100	:	ON APPLICATION FOR
Filed: November 12, 2003	:	PATENT TERM ADJUSTMENT
Atty Docket No. SER-001	:	

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154(b) AND 37 C.F.R. § 1.705(b), filed May 20, 2010. Applicant requests that the patent term adjustment at the time of the mailing of the Notice of Allowance be corrected from two hundred thirty-seven (237) days to five hundred thirty-nine (539) days..

Applicant requests recalculation of the determination of patent term adjustment partly on the basis that the Office will take in excess of three years to issue this patent. In addition to the over three year argument, applicant sets forth two additional bases for correction of the patent term adjustment. First, applicant argues that, pursuant to 37 CFR 1.702(a)(2), a period of adjustment of 30 days should be entered in connection with the Office's mailing of a non-final Office action on October 16, 2007 in response to applicant's May 16, 2007 reply. Second, applicant asserts that the Office improperly entered a 87 day period of reduction pursuant to 37 CFR 1.704(c)(8) in connection with the filing of an Information Disclosure Statement on February 4, 2010, after applicant filed an appeal brief on November 9, 2009.

To the extent that applicant requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued. Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent or even the filing date of the request for continued examination is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that he may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

To the extent that applicant otherwise requests correction of the initial determination of patent term adjustment (PTA), the application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment determination at the time of the mailing of the Notice of Allowance is **three hundred twenty-four (324) days**. A copy of the updated PALM screen, showing the determination, is enclosed.

On February 23, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 237 days.

First, pursuant to 37 CFR 1.702(a)(2), applicant argues that a period of adjustment of 30 days should be entered in connection with the Office's mailing of a non-final Office action on October 16, 2007 in response to applicant's May 16, 2007 reply. A reply was filed on May 16, 2007 in response to the March 14, 2007 final Office action. On August 6, 2007 a non-final Office action was mailed. Applicant asserts the August 6, 2007 was subsequently vacated on October 16, 2007, when a second non-final Office action was mailed. It is applicant's position that the withdrawal of a timely Office action and the issuance of new Office action after four months from the date a reply was filed should not be considered timely for the purposes of calculating patent term adjustment.

Applicant would have the Office accord 30 days of Office delay on the basis that the non-final Office action of October 16, 2007 more completely responds to his May 16, 2007 reply after final Office action. Applicant argues that the Office failed to mail an action under 35 U.S.C. § 132 not later than 4 months after applicant's May 16, 2007 reply under § 1.113 was filed.

37 CFR 1.702(a) provides, in pertinent part, that grounds for adjustment of patent term due to examination delay include failure of the Office to

- (2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

37 CFR 1.703(a) provides, in pertinent part, the periods are calculated as follows:

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(3) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

Regarding the period of Office delay, pursuant to 37 C.F.R. § 1.703(a)(3), applicant submitted a RCE and amendment on May 16, 2007. The Office mailed a non-final Office action on August 6, 2007, which is within the four months of the filing of the May 16, 2007 RCE and amendment. Therefore, no period of adjustment was entered pursuant to 37 CFR 1.703(a)(3).

Applicant's argument that this calculation is incorrect has been considered but not found persuasive. In reply to applicant's May 16, 2007 reply, the Office mailed a non-final Office action on August 6, 2007. This was in response to and within four months of the date the reply was filed. The fact that the Office mailed an Office action on October 16, 2007 which also referenced the reply filed May 16, 2007 does not negate the fact that the Office first mailed an action under 35 U.S.C. §132 in response on August 6, 2007. Accordingly, Office delay in taking action in response to the reply filed May 16, 2007 was properly calculated as zero (0) days.

Second, applicant asserts the Office improperly entered a reduction pursuant to 37 CFR 1.704(c)(8) in connection with the filing of an Information Disclosure Statement on February 4, 2010 after applicant filed an appeal brief on November 9, 2009. A review of the application history reveals that applicant is correct. Ordinarily there are no reductions during the appeal period. The February 4, 2010 IDS is not a supplemental reply within the meaning on 37 CFR 1.704(c)(8) because no period was running against applicant. Therefore, there was no failure to engage and no reduction is warranted in connection with the filing of the IDS on February 4, 2010. Accordingly, the

reduction of 87 days associated with the filing of the February 4, 2010 IDS is being removed.

In view thereof, the determination of patent term adjustment at the time of mailing of the Notice of Allowance is **three hundred twenty-four (324) days** (491 days of Office delay - 167 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Shirene Willis Brantley at (571) 272-3230.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of adjusted PALM calculation

Day : Saturday
Date: 8/14/2010

PALM INTRANET

Time: 14:51:35

PTA Calculations for Application: 10/706100

Application Filing Date:	11/12/2003	PTO Delay (PTO):	491
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	254
Post-Issue Petitions:	0	Total PTA (days):	324
PTO Delay Adjustment:	87		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
132	08/14/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	87		
119	02/16/2010	ISSUE REVISION COMPLETED			
118	02/16/2010	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
117	02/16/2010	CASE DOCKETED TO EXAMINER IN GAU			
116	02/16/2010	DOCUMENT VERIFICATION			
115	02/05/2010	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
114	02/04/2010	REFERENCE CAPTURE ON IDS			
113	02/04/2010	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		87	104
112	02/08/2010	EXAMINER'S AMENDMENT COMMUNICATION			
111	02/08/2010	NOTICE OF ALLOWABILITY			
110	03/05/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
109	05/08/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
108	02/04/2010	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
107	02/04/2010	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
106	11/24/2009	APPEAL BRIEF REVIEW COMPLETE			
105	11/17/2009	DATE FORWARDED TO EXAMINER			
104	11/09/2009	APPEAL BRIEF FILED			
103	11/09/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
102	11/05/2009	EMAIL NOTIFICATION			
101	11/05/2009	MAIL ADVISORY ACTION (PTOL - 303)			

100	11/03/2009	ADVISORY ACTION (PTOL-303)			
99	08/15/2008	REFERENCE CAPTURE ON IDS			
98	08/15/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	75
97	05/08/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
96	05/08/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
95	05/08/2009	NOTICE OF APPEAL FILED		30	81
94	05/08/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
93	05/08/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
92	03/12/2009	EMAIL NOTIFICATION			
91	03/12/2009	MAIL ADVISORY ACTION (PTOL - 303)			
90	03/09/2009	ADVISORY ACTION (PTOL-303)			
89	03/05/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
88	02/12/2009	DATE FORWARDED TO EXAMINER			
87	02/10/2009	AMENDMENT AFTER FINAL REJECTION			
86	02/12/2009	EMAIL NOTIFICATION			
85	02/12/2009	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
84	02/03/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
83	01/08/2009	ELECTRONIC REVIEW			
82	01/08/2009	EMAIL NOTIFICATION			
81	01/08/2009	MAIL FINAL REJECTION (PTOL - 326)	24		75
80	01/05/2009	FINAL REJECTION			
79	08/15/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
78	08/15/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
77	08/15/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
76	09/18/2008	DATE FORWARDED TO EXAMINER			
75	08/15/2008	RESPONSE TO RULE 105 REQUIRED FOR INFORMATION FILED			
74	07/16/2008	MAIL INDEPENDENT RULE 105 COMMUNICATION			
		INDEPENDENT COMMUNICATION UNDER RULE			

73	07/14/2008	105			
65	05/15/2008	DATE FORWARDED TO EXAMINER			
64	04/08/2008	RESPONSE AFTER NON-FINAL ACTION		83	58
63	04/08/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
62	04/08/2008	NEW OR ADDITIONAL DRAWING FILED			
61	10/29/2007	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
60	10/23/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
59	10/16/2007	MAIL NOTICE OF WITHDRAWN ACTION			
58	10/16/2007	MAIL NON-FINAL REJECTION			
57	10/15/2007	NON-FINAL REJECTION			
56	10/15/2007	DATE FORWARDED TO EXAMINER			
55	10/15/2007	LETTER WITHDRAWING / VACATING OFFICE ACTION			
54	09/18/2007	MISCELLANEOUS INCOMING LETTER			
53	09/11/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
52	08/06/2007	MAIL NON-FINAL REJECTION			
51	08/03/2007	NON-FINAL REJECTION			
50	06/18/2007	CASE DOCKETED TO EXAMINER IN GAU			
49	05/16/2007	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
48	05/23/2007	DATE FORWARDED TO EXAMINER			
47	05/16/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
46	05/23/2007	DATE FORWARDED TO EXAMINER			
45	05/16/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
44	05/23/2007	DISPOSAL FOR A RCE / CPA / R129			
43	05/16/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
42	05/01/2007	CORRESPONDENCE ADDRESS CHANGE			
41	05/01/2007	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
40	04/30/2007	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
39	03/08/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
38	03/14/2007	MAIL FINAL REJECTION (PTOL - 326)			

37	03/07/2007	FINAL REJECTION			
36	12/26/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
35	12/26/2006	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
34	12/26/2006	REFERENCE CAPTURE ON IDS			
33.7	12/26/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	31
33	12/26/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
32	01/25/2007	DATE FORWARDED TO EXAMINER			
31	12/26/2006	RESPONSE AFTER NON-FINAL ACTION		54	29
30	12/26/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
29	08/02/2006	MAIL NON-FINAL REJECTION			
28	07/28/2006	NON-FINAL REJECTION			
27	06/21/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
26	10/22/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
25	05/25/2006	DATE FORWARDED TO EXAMINER			
24	05/22/2006	RESPONSE TO ELECTION / RESTRICTION FILED			
23	04/24/2006	MAIL RESTRICTION REQUIREMENT	467		-1
22	04/20/2006	REQUIREMENT FOR RESTRICTION / ELECTION			
21	10/06/2005	PRELIMINARY AMENDMENT			
20	06/28/2005	CASE DOCKETED TO EXAMINER IN GAU			
19	10/22/2004	REFERENCE CAPTURE ON IDS			
18.7	10/22/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18	10/22/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	07/13/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
16	07/13/2004	CASE DOCKETED TO EXAMINER IN GAU			
15	06/21/2004	REFERENCE CAPTURE ON IDS			
14.7	06/21/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	06/21/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
13	04/07/2004	APPLICATION RETURN FROM OIPE			

12	04/07/2004	APPLICATION RETURN TO OIPE			
11	04/07/2004	APPLICATION DISPATCHED FROM OIPE			
10	04/07/2004	APPLICATION IS NOW COMPLETE			
9	03/29/2004	ADDITIONAL APPLICATION FILING FEES			
8	03/29/2004	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
7	03/09/2004	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
5	02/24/2004	CLEARED BY L&R (LARS)			
4	01/30/2004	REFERRED TO LEVEL 2 (LARS) BY OIPE CSR			
3	01/30/2004	CASE CLASSIFIED BY OIPE			
2	12/22/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	11/12/2003	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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